

### REMARKS

Claims 1-13 are in this application. Claims 1-5 have been withdrawn from further consideration, and elected claims 6-13 have been rejected.

Claims 6-13 are drawn to a process for treating a surface or compound with a building block of the formula



It is an essential feature of the present invention that said building block combines a free isocyanate group with a functional group (Y) within one molecule, therefore, this building block is able to connect the surface and the functional group (Y) via covalent bonds (the free isocyanate group reacts with a functional group of the surface resulting in a covalent urethane bond).

The claimed invention provides a method to modify or functionalize surfaces in a "tailor-made" way by appropriate selection of the Y group, e.g., when Y is H hydrophilic surfaces can be made more hydrophobic.

The references relied on the examiner under 35 USC § 103 do not disclose any process even similar to the one here claimed. A more detailed discussion shall be presented below.

Claims 6, 8 and 11-13 have been rejected under 35 USC § 103(a) as being unpatentable over Matsuda et al., US 4,008,196 (Matsuda). This rejection is respectfully traversed.

Matsuda discloses a process for the production of an amphoteric resinous

aqueous solution that is useful for the treatment of fiber containing products. Said process comprises the following steps:

- producing an NCO containing prepolymer,
- reacting said prepolymer with a polyamine, wherein the resulting polymer contains  $\text{-NH}_2$  groups but does not contain any free NCO groups,
- partially reacting the  $\text{-NH}_2$  groups containing prepolymer with an alkyl-monoisocyanate in order to get a polymer having  $\text{NH}_2$ -groups and long chain alkyl groups, but no free NCO groups,
- reacting the thus-formed product with, e.g., caprolactone,
- emulsifying the above obtained polymer in water and treating fibers with the resulting emulsion.

The process of Matsuda is totally different from the process of the instant claims.

As can be seen from the above description, only the first step of the Matsuda process utilizes an NCO containing reactant. However, that reactant is quite different from applicants' compound (1). Thus, to whatever extent the examiner may be equating the first step of the Matsuda process to the process of the instant claims, that equation would be erroneous on its face.

Matsuda does not teach a process for modifying compounds or surfaces by causing them to react with a polyfunctional isocyanate such as instant compound (1). The only surface modifying composition disclosed by Matsuda has long since had its free NCO groups converted to other groups in the formation of the actual modifying

composition.

To find in the disclosure of Matsuda any suggestion of the instant invention and/or motivation to use it would require an incredible leap of the imagination. The requirements for establishing a *prima facie* case of obviousness over the prior art are set forth in MPEP §§ 706.02(j) and 2141-2143.03, and the cases cited therein. For a good explanation of the type of reasoning required to be set forth by an examiner to support a *prima facie* case of obviousness, see *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993). Neither sufficiently relevant teachings in Matsuda nor an appropriate explanation of how the Matsuda teachings could properly give rise to a *prima facie* case of obviousness are to be found on the present record.

Claims 6, 8 and 11-13 have been rejected under 35 USC § 103(a) as being unpatentable over Kim et al., US 4,180,491 (Kim). This rejection is respectfully traversed.

Kim discloses print pastes comprising a thickener concentrate containing a nonionic polyurethane having at least 3 hydrophobic branching groups linked through hydrophilic polyether segments. However, the polymers disclosed in Kim do not contain any free isocyanate groups (see col. 4, "the ratio of total equivalents of active hydrogen containing reactants to isocyanate reactants is at least 1:1. A slight excess ... may be used to eliminate any unreacted isocyanate functionality").

The disclosure of Kim is clearly even more remote from the claimed invention than is that of Matsuda and a suitable explanation based on logic and sound scientific

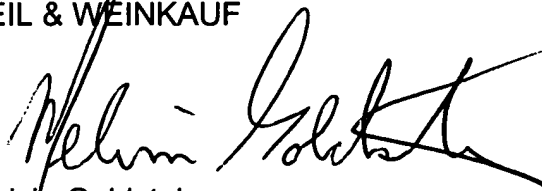
reasoning as to how one of ordinary skill in the relevant art would have derived applicants' invention from that disclosure is even more clearly required.

In light of the foregoing remarks, it is hoped that the examiner will see the errors in the rejections of record, and will allow claims 6-13. Such action is respectfully solicited.

To the extent necessary, applicant(s) petition for an Extension of Time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read 'Melvin Goldstein', is written over the printed name.

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